

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLN. NO. 09/832,828
ATTORNEY DOCKET NO. Q60535

REMARKS

Applicants request that the Patent Office acknowledge Applicants' claim to domestic priority to U.S. Provisional Application No. 60/227,852 as evidenced by paragraph [0001] of the specification of the U.S. Application No. 09/832,828 filed on April 12, 2001.

Applicants thank the Patent Office for initialing the references listed on the PTO-1449 form submitted with the Information Disclosure Statement filed on April 12, 2001, thereby confirming that the listed references have been considered.

Claims 1-57 have been examined on their merits.

Applicants herein cancel claims 5, 6, 9, 24, 25, 42 and 56 without prejudice and/or disclaimer.

Applicants herein amend claims 2-4, 7, 8, 10-13, 15-18, 20, 22, 23, 26-33, 35, 38, 39, 43-46, 48 and 52-54 for reasons of precision of language. The amendments to claims 2-4, 7, 8, 10-13, 15-18, 20, 22, 23, 26-33, 35, 38, 39, 43-46, 48 and 52-54 were made merely to more accurately claim the present invention and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 2-4, 7, 8, 10-13, 15-18, 20, 22, 23, 26-33, 35, 38, 39, 43-46, 48 and 52-54 were not made for reasons of patentability.

Claims 1-4, 7, 8, 10-23, 26-41 and 43-55 and 57 are all the claims presently pending in the application.

1. Claims 1-9, 11-17, 31-45 and 47-53 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Tso *et al.* (U.S. Patent No. 6,047,327). The rejection of claims 5, 6, 9 and 42 is now moot due to their cancellation. Applicants traverse the rejection of claims 1-4, 7, 8, 11-17, 31-41, 43-45 and 47-53 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

With respect to claim 1, Tso *et al.* do not teach or suggest arranging selected data items for display according to a plurality of presentation rules, as recite in claim 1. As illustrated in Figure 5 of Tso *et al.*, the information received from the content providers is filters and information that matches predetermined criteria is sent to the client and displayed. *See, e.g.*, col. 14, lines 35-67 of Tso *et al.* There is no disclosure in Tso *et al.*, however, that the selected information received from the content providers is arranged according to any set of presentation rules, as recited in claim 1 of the present invention. Figure 5 of Tso *et al.* makes it clear that if

the user does not wish to make use of the information, the process ends. *See* col. 15, lines 4-11 of Tso *et al.* There is no arranging of selected data items for display according to a plurality of presentation rules. Moreover, there is no disclosure in Tso *et al.* that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application.

Based on the foregoing reasons, Applicants submit that Tso *et al.* fail to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Tso *et al.* clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claims 2-4, 7, 8 and 11-13 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 1-4, 7, 8 and 11-13.

Independent claim 14 has similar recitations as claim 1. Applicants submit that claim 14 is allowable for at least the same reasons as claim 1, in that Tso *et al.* fail to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Applicants submit that claims 15-17 are allowable as well, at least by virtue of their dependency from claim 14. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 14-17.

Independent claim 19 has similar recitations as claim 1. Applicants submit that claim 19 is allowable for at least the same reasons as claim 1, in that Tso *et al.* fail to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Applicants submit that claims 20-23, 25-29 and 31-33 are allowable as well, at least by virtue of their dependency from claim 19. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 19-23, 25-29 and 31-33.

Independent claim 34 has similar recitations as claim 1. Applicants submit that claim 34 is allowable for at least the same reasons as claim 1, in that Tso *et al.* fail to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Applicants submit that claims 35-41 and 43-45 are allowable as well, at least by virtue of their dependency from claim 34. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 34-41 and 43-45.

Independent claim 47 has similar recitations as claim 1. Applicants submit that claim 47 is allowable for at least the same reasons as claim 1, in that Tso *et al.* fail to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and

transmitted to the outside application. Applicants submit that claims 48-53 are allowable as well, at least by virtue of their dependency from claim 47. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 47-53.

2. Claims 41 and 51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso *et al.* Applicants traverse the rejection of claims 41 and 51 for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

As threshold matter, Applicants point out that since claims 41 and 51 depend upon claims 34 and 47, respectively, and since the Patent Office does not cite a reference which cures the deficient teachings of Tso *et al.* with respect to claims 34 and 47, Applicants submit that claims 41 and 51 are patentable at least by reason of their dependency from claims 34 and 47, respectively.

However, additionally and independently, Applicants traverse the 35 U.S.C. § 103(a) rejections shown above based on the following discussion. The Patent Office makes the broad statement of obviousness, which regard to all of the elements in claims 41 and 51, by taking

“Official Notice.” The Patent Office has not provided any documentary evidence that it is well-known to one of ordinary skill in the art to use an interactive voice response server and how this element is known to those of ordinary skill in the art. The Patent Office must provide documentary evidence if reliance on Official Notice is to be maintained. *See* 37 C.F.R. § 1.104(c)(2) and MPEP § 2144.04(C). The mere fact that the claimed invention is within the capabilities or familiarities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness. *See* MPEP § 2143.01. The characterization of certain claim limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Patent Office to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *In re Lahu*, (747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984)). Furthermore, the Patent Office may not rely on official notice, or judicial notice, or a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965). The Patent Office has not cited, nor have the Applicants identified, any prior art which teaches or suggests the invention recited in claims 41 and 51.

3. Claims 10, 18, 30, 46 and 54 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso *et al.* in view of Gerace (U.S. Patent No. 5,848,396). Applicants traverse the rejection of claims 10, 18, 30, 46 and 54 for at least the reasons discussed below.

Claim 10 depends from claim 1, and includes all the recitations of claim 1 by virtue of its dependency. The combination of Tso *et al.* and Gerace does not teach or suggest arranging data items for display according to subscriber selected presentation rules, as recited in claim 1, and included in claim 10 via dependency. At best, the combination of Tso *et al.* and Gerace discloses a device that learns a user's habits based on the types of information selected for perusal. *See, e.g.,* col. 2, lines 1-23 of Gerace. The combination of Tso *et al.* and Gerace disclose that the display rules for a user's home page are based on user viewing habits over time. While the user creates an initial set of display rules, these display rules are modified by the user's viewing habits, and not by the user's direct selection of a particular display rule. *See* col. 4, lines 1-35 of Gerace. Moreover, the combination of Tso *et al.* and Gerace fail to teach or suggest that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants submit that the Patent Office cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Tso *et al.* nor Gerace disclose the arranging data items for display according to subscriber selected presentation rules or the data item push, Applicants submit that one of skill in the art would not be motivated to combine the references. *In re Dembiczak* and *In*

re Zurko require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Patent Office must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Although the Patent Office provides a motivation analysis with respect to a dynamic homepage for a mobile system, both *Tso et al.* and *Gerace* lack any teaching about the desirability of arranging data items for display according to subscriber selected presentation rules. *Tso et al.* disclose the pushing of content items that are filtered from a plurality of sources, and those items are not arranged for display in any sort of manner. *Gerace* discloses arranging content items based on a user's selection habits over time. Since *Tso et al.* forwards content items for viewing based on predetermined filters, Applicants submit that one of ordinary skill would not turn to *Gerace*, since the content items of *Tso et al.* are either further queried or discarded *in seriatim*. There would be no need to develop display rules over time, since *Tso et al.* do not display multiple content items. Furthermore, neither reference discloses that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants submit that the Patent Office cannot fulfill the

motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that the combination of Tso *et al.* and Gerace fails to disclose all of the claimed elements as arranged in claim 1, and included via dependency in claim 10. Therefore, the combination of Tso *et al.* and Gerace clearly cannot render the present invention obvious as recited in claim 10. Thus, Applicants submit that claim 10 is allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 10.

Claim 18 depends from claim 14, and includes all the recitations of claim 14 by virtue of its dependency. Applicants submit that claim 18 is allowable for at least the same reasons as claim 10, in that combination of Tso *et al.* and Gerace fails to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 18.

Claim 30 depends from claim 19, and includes all the recitations of claim 19 by virtue of its dependency. Applicants submit that claim 30 is allowable for at least the same reasons as claim 10, in that combination of Tso *et al.* and Gerace fails to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside

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application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 30.

Claim 46 depends from claim 34, and includes all the recitations of claim 34 by virtue of its dependency. Applicants submit that claim 46 is allowable for at least the same reasons as claim 10, in that combination of Tso *et al.* and Gerace fails to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 46.

Claim 54 depends from claim 47, and includes all the recitations of claim 47 by virtue of its dependency. Applicants submit that claim 54 is allowable for at least the same reasons as claim 10, in that combination of Tso *et al.* and Gerace fails to teach or suggest arranging data items according to a plurality of presentation rules, or that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants respectfully request that the Patent Office withdraw the § 103(a) rejection of claim 54.

4. Claims 55-57 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Tso *et al.* in further view Kaplan *et al.* (U.S. Patent No. 5,446,891). The rejection of claim 56 is now moot due to its cancellation. Applicants traverse the rejection of claims 55 and 57 for at least the reasons discussed below.

The combination of Tso *et al.* and Kaplan *et al.* does not teach or suggest arranging data items for presentation according to a subscriber edited profile, as recited in claim 55 and 57. Kaplan *et al.* relies upon multiple content items being available for selection, whereas Tso *et al.* shows content items in a serial fashion. In addition, Kaplan *et al.* discloses arranging items according to predefined link weights, which is completely different from the presentation rules of the present invention. Moreover, neither reference teaches or suggests that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Tso *et al.* nor Kaplan *et al.* disclose the arranging data items for display according to subscriber selected presentation rules, Applicants submit that one of skill in the art would not be motivated to combine the references. Although the Patent Office provides a motivation analysis with respect to a dynamic homepage for a mobile system, both Tso *et al.* and Kaplan *et al.* lack any teaching about the desirability of arranging data items for display according to subscriber selected presentation rules. Tso *et al.* disclose the pushing of content

items that are filtered from a plurality of sources, and those items are not arranged for display in any sort of manner. Kaplan *et al.* disclose arranging items based on a link weights. Since Tso *et al.* forwards content items for viewing based on predetermined filters, Applicants submit that one of ordinary skill would not turn to Kaplan *et al.*, since the content items of Tso *et al.* are either further queried or discarded *in seriatim*. There would be no need to develop display rules based on link weights, since Tso *et al.* do not display multiple content items. Finally, neither reference teaches or suggests that the data items received from an outside application comprise personalized information pushed to the subscriber by the outside application according to a provisioning profile associated with the subscriber and transmitted to the outside application. Thus, Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.


Based on the foregoing reasons, Applicants submit that the combination of Tso *et al.* and Kaplan *et al.* fails to disclose all of the claimed elements as arranged in claims 55 and 57. Therefore, the combination of Tso *et al.* and Kaplan *et al.* clearly cannot render the present invention obvious as recited in claims 55 and 57. Thus, Applicants submit that claims 55 and 57 are allowable, and respectfully request that the Patent Office withdraw the § 103(a) rejection of claims 55 and 57.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Patent Office feels may be best resolved through a personal or telephone interview, the Patent Office is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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23373

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Date: June 1, 2004